

REMARKS

Claims 1-2, 6-7, 9-12, and 15-19, as amended, and new claims 20-25 are currently pending.¹ In this Response, Applicants have amended certain claims. In light of the Office Action, Applicants believe these amendments serve a useful clarification purpose, and are desirable for clarification purposes, independent of patentability. Accordingly, Applicants respectfully submit that the claim amendments do not limit the range of any permissible equivalents.

In particular, independent claims 1, 9, and 15 have been rewritten to further clarify the embodiments of the present invention recited therein. Various dependent claims have been rewritten or canceled to maintain consistency with the language now recited in the independent claims. Furthermore, claims 20-25 have been added to recite embodiments fully supported by the Written Description. As no new matter has been added, Applicants respectfully request entry of these amendments at this time.

REJECTION UNDER 35 U.S.C. § 112

Claims 1-13 were rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for the reasons provided on page 2. In light of the amendments herein, Applicants respectfully submit that the rejection is overcome.

THE REJECTIONS UNDER 35 U.S.C. §§ 102 & 103

Claims 14-18 were rejected under 35 U.S.C. § 102(b) as anticipated by or, in the alternative, under 35 U.S.C. § 103(a) as obvious over U.S. Patent No. 3,583,943 to Weber ("Weber") or Japanese Patent Publication No. 9040734 ("the '734 publication"). In addition, claims 1-4, 8, 14-16, and 18 were rejected under 35 U.S.C. § 102(b) as anticipated by or, in the alternative, under 35 U.S.C. § 103(a) as obvious over U.S. Patent No. 4,123,061 to Dusbiber ("Dusbiber"). In addition, the Examiner rejected claims 1-4, 8, 14-16, and 18 under 35 U.S.C. § 102(b) or, in the alternative, under 35 U.S.C. § 103(a) as obvious over U.S. Patent No. 6,309,313 to Peter ("Peter"). Moreover, claims 1-4, 8, 14-16, and 18 were rejected under 35 U.S.C. § 102(b) or, in the alternative, under 35 U.S.C. § 103(a) as obvious over U.S. Patent No. 4,124,573 to Watabe ("Watabe"). Claims 1-4 were also rejected 35

¹ Applicants note that, due to a second claim 9 in the original claim listing, claims 9-18 are now claims 9-19.

U.S.C. § 102(b) or, in the alternative, under 35 U.S.C. § 103(a) as obvious over U.S. Patent No. 5,484,870 to Wu ("Wu '870"). Finally, claims 1-13 were rejected under § 102(a, e) or § 103(a) as obvious over U.S. Patent Publication No. 2003/0096936 ("Wu '936"). None of the cited references disclose or suggest the present invention for at least the reasons that follow.

Weber and the '734 Publication Do Not Disclose or Suggest the Invention in Claims 14-18

Both Weber and the '734 publication are directed to general chemical compositions included various polyurethane and/or polyurea components. In contrast, the present invention is directed to compositions for use in golf balls. In order to clarify the invention, claims 14-18 have been rewritten to recite a golf ball including the particular composition recited therein. As such, Applicants respectfully submit that neither Weber nor the '734 publication teach or suggest the present invention. Applicants therefore request reconsideration and withdrawal of the §§ 102 and 103 rejections based thereon.

Dusbiber, Peter, Watabe, and Wu '870
Do Not Anticipate or Render Obvious the Present Invention

Dusbiber, Peter, Watabe, and Wu generally disclose polyurethane cover compositions for golf balls that include prepolymers that are cured with various curing agents. As recognized by the Examiner, all of these references are completely silent at least with respect to the features that were recited in claims 5, 6, 7, and 9-13, as originally filed. As such, because claim 1 now includes the features previously recited in claim 5, Applicants respectfully submit that none of these references anticipate or render obvious the presently recited invention. Thus, Applicants respectfully request reconsideration and withdrawal of the §§ 102 and 103 rejections based thereon.

Wu '936 Does Not Anticipate or Render Obvious the Present Invention

As apparently recognized by the Examiner, Wu '936 is silent as to the average molecular weight between crosslinks presently recited in claim 15. As such, Applicants have rewritten claims 1 and 9 to reflect this subject matter. Therefore, Applicants respectfully submit that Wu '936 does not anticipate or render obvious the present invention.

In addition, Applicants respectfully submit that Wu '936 is unavailable as prior art under § 102(e) under 35 U.S.C. § 103(c). Section 103(c) provides that a § 102(e) reference may not preclude patentability if its subject matter and the claimed invention were commonly

owned at the time the invention was made. 35 U.S.C. § 103(c)(2000). See also, MPEP § 706.02(l)(1). The present application and Wu '936 were, at the time of invention of this application, owned by Acushnet Company. In support of this, Applicants respectfully direct the Examiner to the assignment filed with this application and the front page of the Wu '936 publication.

For the reasons above, Applicants respectfully request reconsideration and withdrawal of the §§ 102 and 103 rejections based thereon.

DOUBLE PATENTING REJECTION

The Examiner rejected claims 1-13 under the judicially created doctrine of obviousness-type double patenting based on claims 1-27 of U.S. Patent No. 6,835,794. In addition, the Examiner rejected claims 1-13 for obviousness-type double patenting based on claims 1-27 of co-pending U.S. Patent Application No. 10/820,124. In light of the Terminal Disclaimer submitted herewith, Applicants respectfully submit that the double patenting rejections are overcome.

CONCLUSION

All claims are believed to be in condition for allowance. If the Examiner believes that the present amendments still do not resolve all of the issues regarding patentability of the pending claims, Applicants invite the Examiner to contact the undersigned attorneys to discuss any remaining issues.

A Petition for Extension of Time is submitted herewith to extend the time for response three months to and including March 1, 2006. In addition, a Fee Sheet Transmittal is submitted to authorize the charge for the Terminal Disclaimer.

No other fees are believed to be due at this time. Should any fee be required, however, please charge such fee to Bingham McCutchen LLP Deposit Account No. 195127, Order No. 20002.0329.

Respectfully submitted,
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